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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/862,636      | 05/22/2001  | Ervin Goldfain       | 281-329.02          | 1483             |

7590 02/12/2003

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EXAMINER

SANDERS JR, JOHN R

ART UNIT

PAPER NUMBER

3737

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

|                              |                               |                                 |  |
|------------------------------|-------------------------------|---------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/862,636 | Applicant(s)<br>GOLDFAIN ET AL. |  |
|                              | Examiner<br>John R. Sanders   | Art Unit<br>3737                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 8, 9, 11, 16, 18 and 46-53 is/are allowed.
- 6) ☒ Claim(s) 12-15, 17, 19-21, 23-25, 27-29, 32, 35-38, 41, 44 and 45 is/are rejected.
- 7) ☒ Claim(s) 7, 10, 22, 26, 30, 31, 33, 34, 39, 40, 42 and 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3 &amp; 7</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Inventorship***

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not identify the citizenship of each inventor.

### ***Drawings***

3. This application has been filed with informal drawings, specifically FIGS. 6A-6K, that are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

***Specification***

4. The disclosure is objected to because of the following informalities: Tables 1 and 3 appear to be improperly formatted. Consider a lined table with separate columns for each of Radius, Thickness, Aperture Radius, and Material.

***Claim Objections***

5. Claims 7, 10, 21, 22, 36 and 45 are objected to because of the following informalities: The preambles of claims 10, 21 and 22 should read --The eye viewing device of claim-- for consistency in the claims. Claim 7 appears to be a duplicate of claim 5. Claims 36 and 45 appear to be duplicates of claims 29 and 38, respectively. Appropriate correction and/or cancellation of the claims are required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12-15, 17, 19-21 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 12-15 and 17 recite the limitation "said communication link". Claims 19-21 recite the limitation "said mating connectors". Claim 27 recites the limitation "said holder and said module". There are insufficient antecedent bases for these limitations in the claims.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 23, 24, 28, 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,116,736 to *Stark et al.* *Stark et al.* discloses a hand-held housing (12) having an observer end (30) and a patient end (22); an illumination system disposed in the housing (24, 28); an imaging system disposed in the housing (16); an image sensor (14); and a processor system (34). *Stark et al.* also discloses an electronic display (36). Regarding claim 28, *Stark et al.* discloses a beamsplitter (18) that defines a pair of focal planes, one coinciding with the image sensor (14) and the other with the viewing port (22, 30). The absence of an eyepiece lens in *Stark et al.* does not render the reference irrelevant; it would have been obvious to one of ordinary skill in the art to include an eyepiece lens in the observer path in order to focus or magnify the image for the observer. Also, eyepiece lenses are common in ophthalmic instruments (e.g., see *Urban*, ref. 22).

10. Claims 25, 29 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Stark et al.* in view of U.S. Patent No. 6,152,565 to *Liu et al.*

*Stark et al.* discloses the above limitations but does not disclose expressly a communication link component. *Liu et al.* discloses a communication link component (FIG.1) between a hand-held corneal topography device and a computer.

*Liu et al.* and *Stark et al.* are analogous art because they are from class 351, eye examining and testing equipment.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a communication link with the apparatus of *Stark et al.* The suggestion/motivation for doing so would have been to communicate image data from the handheld device to an external unit. Therefore, it would have been obvious to combine *Liu et al.* with *Stark et al.* to obtain the invention as specified in claims 25, 29 and 36.

11. Claims 37, 41 and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Stark et al.* in view of U.S. Patent No. 3,915,564 to *Urban*.

*Stark et al.* discloses the above limitations but does not disclose expressly a moveable mirror. *Urban* discloses a moveable mirror (24, 24') that defines a focal plane at the camera (29) in the first position and at the eyepiece (22) in the second position.

*Urban* and *Stark et al.* are analogous art because they are from class 351, eye examining and testing equipment.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a moveable mirror in the apparatus of *Stark et al.* The suggestion/motivation for doing so would have been to operably switch between two

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optical paths. Therefore, it would have been obvious to combine *Urban* with *Stark et al.* to obtain the invention as specified in claims 37, 41 and 44.

12. Claims 38 and 45 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Stark et al.* in view of *Urban* and further in view of *Liu et al.*

*Stark et al.* and *Urban* disclose the above limitations but do not disclose expressly a communication link component. By the reasoning applied in paragraph 10 above, it would have been obvious to combine *Liu et al.* with *Stark et al.* and *Urban* to obtain the invention as specified in claims 38 and 45.

### ***Allowable Subject Matter***

13. Claim 1-6, 8, 9, 11, 16, 18 and 46-53 are allowed.

14. Claims 7, 10, 21 and 22 are objected to, but would be allowable if rewritten to overcome the claim objections set forth in this Office Action.

15. Claims 26, 30, 31, 33, 34, 39, 40, 42 and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Carter* and *Yancey* disclose handheld apparatuses. *Kohayakawa* discloses multiple instances of moveable mirrors.

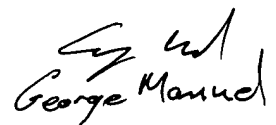
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Sanders whose telephone number is (703) 305-4974. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin M. Lateef can be reached on (703) 308-3256. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



jrs  
February 7, 2003



George Manuel